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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,303	06/23/2000	Scott Lorenz	5053-36000	1772

7590 01/16/2008

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ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
01/16/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT LORENZ

Appeal 2007-3757
Application 09/603,303
Technology Center 3600

Decided: January 16, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Lorenz (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-11, 13-18, and 20-22. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b).[1]

THE INVENTION

The Appellant has claimed subject matter to a system, process, and carrier medium for processing insurance claims. A concise explanation of the claimed subject matter for each independent claim is provided *infra*.[2]

The claim processing system includes an insurance claim processing server having a computer system 20a and a memory 30a coupled thereto (Specification 7:24-25 and Figure 2a). The memory 30a stores a set of

[1] Our decision will refer to Appellant's Supplemental Appeal Brief ("Supp. Br.," filed Mar. 3, 2006), Appellant's Reply Brief ("Reply Br.," filed Jul. 21, 2006 (Certificate of Mailing, Jul. 18, 2006)), and the Examiner's Answer ("Answer," mailed May 18, 2006).

[2] The Appellant is required to submit a summary of the claimed subject matter. 37 C.F.R. § 41.67(c)(1)(v) (2007). As explained in the regulation, the summary of the claimed subject matter is concise explanation of the subject matter defined in each of the independent claims involved in the appeal. The explanation shall refer to the specification by page and line number, drawings (if any), and reference characters. Concise means clean-cut brevity. Repeating what is stated in the Summary of the Invention section of the Specification is not concisely explaining the claimed subject matter. Both the Examiner and Appellant identified there was an issue with whether or not the Appeal Brief complied. (Notification of Non-Compliant Appeal Brief, mailed Feb. 1, 2006 and Response to Notice of Non-Compliant Appeal Brief, filed Mar. 3, 2006, pages 1 and 2). As such, in order to not overburden the Appellant and expedite this appeal, the decision will provide a summary of the claimed subject matter.

program instructions 60 which are executable by the computer system 20a to estimate the value of an insurance claims that include bodily injury general damages (Specification 3:7-9 and 10:12-17). This estimation is a function of the insurance claim assessment data entered by a user (Specification 11:7-10 and 14:30 to 15:2). The insurance claim assessment data includes one or more bodily injury categories, user-inputted data following an answered questionnaire, and the treatment of those bodily injuries (Specification 3:9-10, 14:28-30, 17:29 to 18:4, 22:24 to 23:1, 26:22-24, and Figure 6). Additionally included in the set of program instructions 60 is a sequence of insurance claim processing steps, such as receiving an input from a user of the system, reading a value from a database, updating a field in a database, displaying results of a given business transaction on a computer screen, to complete an insurance transaction (Specification 12:7-21). Both the number of insurance claim processing steps and the sequence of these steps are dynamically established by the set of program instructions 60 (Specification 13:25-27). In addition, the claim processing system includes at least one client computer 80 having a processor 20b and memory 30b (Specification 10:19-23 and Figure 2b). This client computer 80 is coupled to the server 70 through a network 55 (Specification 10:25 and Figure 1). The client computer 80 in its memory 30b stores (1) a set of program instructions for execution 68 by the processor 20b in order to permit the client to receive insurance claim assessment data by the user and to send that data across the network 55 to the insurance claim processing server 70 and (2) a set of program instructions associated with a business transaction to be processed

by the claim processing system such as receiving input from a user, reading database values, updating database fields, and display results (Specification 8:13-16, 10:23-24, and 12:19-21). The latter set of program instructions within the client computer 80 is dynamically established by the claim processing system or user (Specification 12:8-9, 13-14 (system) and 15-18 (user)).

In the process for processing insurance claims the user enters insurance claim assessment data, such as, starting with entering a claim identification number, a type of bodily injury, a treatment for the bodily injuring, etc., in response to a plurality of insurance claim assessment questions during an insurance claim consultation session (Specification, 13:17-19, and 22:24 to 23:1). The insurance claim assessment data is then sent across a network 55 via one or more Internet protocols to an insurance claim processing server 70 (Specification 8:13-16). The insurance claim processing server executes insurance claim processing steps to estimate a value of an insurance claim as a function of the insurance claim assessment data. (Specification 3:7-9, 10:12-17, 11:7-10, and 14:30 to 15:2). The number of insurance claim processing steps and/or sequence of execution of the insurance claims processing steps are dynamically established by the claim processing system or user (Specification 12:8-9, 13-14 (system), and 15-18(user)).

The carrier medium carries the program instructions that facilitate the implementation of the process for processing insurance claims discussed

supra. One of the embodiments of the carrier medium is a transmission signal conveyed across the network 55 (Specification 9:14-16).

Claims 1, 9, and 16, reproduced below, are representative of the subject matter on appeal. The least restrictive claim is being presented first.[3]

> 16. A carrier medium comprising program instructions, wherein the program instructions are computer-executable to implement:
>
> receiving insurance claim assessment data entered by a user in response to a plurality of insurance claim assessment questions during an insurance claim consultation session; and
>
> sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server;
>
> executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.
>
> 9. A method comprising:
>
> receiving insurance claim assessment data entered by a user in response to a plurality of insurance claim

[3] The least restrictive claim should be presented as claim number 1, which is the first claim. 37 C.F.R. § 1.75(g) (2007). Appellant should follow this protocol when further prosecuting this application before the Examiner.

assessment questions during an insurance claim consultation session; and

sending the insurance claim assessment data across a network via one or more Internet protocols to an insurance claim processing server;

executing insurance claim processing steps on the insurance claim processing server to estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time.

1. A system comprising:

an insurance claim processing server comprising a first CPU and a first memory coupled to the first CPU, wherein the first memory stores a first set of program instructions which are executable by the first CPU to:

estimate a value of an insurance claim as a function of insurance claim assessment data, wherein the first set of program instructions further comprise a sequence of insurance claim processing steps executable to complete an insurance claim transaction, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time; and

a client computer system comprising a second CPU and a second memory coupled to the second CPU, wherein the client computer system is coupled to the insurance claim

processing server through a network, wherein the second memory stores a second set of program instructions which are executable by the second CPU to:

receive the insurance claim assessment data entered by a user; and

send the insurance claim assessment data across the network to the insurance claim processing server, wherein the second set of program instructions comprises a sequence of steps established dynamically in real time.

CLAIM CONSTRUCTION

Claims are given the broadest reasonable construction consistent with the specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Claim construction for claim 16

Claim 16 is to a carrier medium having information embedded thereon. The Appellant's Specification describes what embodiments encompass a carrier medium. Two genera are described: storage media and transmission media. The transmission media encompasses "signals such as electrical, electromagnetic, or digital signals" (Specification 9:14-15). Therefore, claim 16 encompasses at least electrical and electromagnetic signals within its scope.

Claim construction for claims 1 and 9

Claims 1 and 9 are directed to a system and a process respectively. When construing claims all limitations are considered in whatever context they are claimed. Where intrinsic evidence unambiguously delineates claims scope, it controls. Such evidence is found within the Specification, Claims and prosecution history.

For apparatus (the system) claims, the question that needs to be answered is whether the limitation under review adds anything structurally significant. For process (the method) claims, the question that needs to be answered is whether the limitation under review adds anything to the practice of the process. There are no bright lines. As such, each is answered on a case-by-case basis.

Claim 1 is directed to a system. The system has an insurance claim processing server. The server contains a processor and a memory. The memory contains a set of programming instructions. The program instructions permit the server through its processor to calculate the estimation of an insurance claim value as a function of insurance claim assessment data. The limitation of the insurance claim processing server having a processor and a memory and associated program instructions in order to estimate a value of an insurance claim is structurally significant to the operability of the claimed machine.

Claim 9 is directed to a method. The method receives insurance claim assessment data inputted by a user, sends the data across the network to an insurance claim processing server, and executes insurance claim processing

steps to estimate a value of an insurance claim as a function of the data. The processing steps to estimate a value of an insurance claim are limited to being executed on the insurance claim assessment data. It follows that the processing the data on the insurance claim processing server has to occur after the data is sent across the network to the insurance claim procession server. The implicit limitation of the data being processed on the insurance claim processing server after the data has been transmitted over the network to the server is significant to the practice of the claimed process.

THE PRIOR ART REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Borghesi	US 5,950,169	Sep. 7, 1999
Aquila	US 2002/0035488 A1	Mar. 21, 2002[4]
DeFrancesco	US 6,505,176 B2	Jan. 7, 2003

The following rejections are before use for review:

1. Claims 1-2, 5-11, and 13-15[5] are rejected under 35 U.S.C. § 103(a) as being unpatentable over Borghesi in view of DeFrancesco.

[4] The Application has a critical date of Jun. 23, 2000. Aquila has a non-provisional filing date of Apr. 3, 2001 and a provisional filing date of Apr. 3, 2000. Appellant has not challenged whether the teachings the Examiner relied upon are prior to the critical date of Appellant's claimed invention.

2. Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Borghesi in view of DeFrancesco as applied to claim 1, and further in view of Aquila.

ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in rejecting claims 1-2, 5-11, and 13-15 as unpatentable over Borghesi and DeFrancesco. The second issue is whether the Appellant has shown that the Examiner erred in rejecting claims 3 and 4 as unpatentable over Borghesi, DeFrancesco, and Aquila. Both issues turn on whether the cited prior art discloses, teaches, or suggests an insurance claim processing server performing the estimation of an insurance claim value as a function of insurance claim assessment data received across a network from a client computer system.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

[5] The rejection of claims 16-18 and 20-22 under 35 U.S.C. § 103(a) is no longer before us for review for the reasons *supra*.

1. The concise explanation of the claimed subject matter on appeal *supra*.

The scope and content of the prior art

2. Borghesi discloses a system for processing automobile insurance claims in order to automate the claim process shown in Figure 1. (Borghesi, col. 4, ll. 65-66 and Fig. 1.) In lieu of using separate processes, paperwork, and programs, Borghesi discloses the creation of one datafile. The datafile contains data on the insured, on the claim, on satisfying the claim, and an event log that tracks all action taken on the datafile. (Borghesi, col. 4, ll. 47-63.) The datafile is an electronic datafile stored on a memory device and is transferable or may be copied to provide status information to insurance company personnel. (Borghesi, col. 5, ll. 28-36.) Figure 3 shows the preferred system to implement the automobile claim process. Computers at the home office, claims office, auditor, appraisers, and repair facility are in communication with the communication server 36. Borghesi discloses the communication server 36 having plural memory locations for storing insurance datafiles and communications. (Borghesi, col. 5, ll. 62-64.) The computer at the home office 30 holds the mastercopy of each insurance datafile unless someone, such as an assigned appraiser or repair shop, is working on an assignment associated with that datafile, e.g., providing a estimation of repair, valuation of the vehicle, etc. (Borghesi, col. 6, ll. 1-5.) Figure 4

shows the construct of single user system that would appear to be located at the location of the claims office 30, appraisers 38 and 34, repair facility 40, and claims office, because digital imaging device 70 is connected to the single user system 44 and these locations are the logical locations to need access to a means for recording vehicle damage to be appended to the datafile. (Borghesi, col. 6, ll. 33-35 and 52-67.) Whereas, Figure 5 shows the construct of the system with multiple computers located at each location: home office 30, claims office 32, and auditor 34. (Borghesi, col. 6, ll. 33-35.) The system in Figure 5 consists of a server 74, a primary workstation 76, and secondary workstations 78 and all are connected via communication line 72. (Borghesi, col. 7, ll. 4-9.) Each computer on the system shown in Figure 5 permits a user to view and manipulate the datafile. (Borghesi, col. 7, ll. 23-25.) As such, each remote computer, whether single user computer embodiment (Figure 4) or a computer on a local area network embodiment (Figure 5) provides an interface for a user to access an assigned or pertinent datafile. (Borghesi, col. 7, ll. 40-42.) The interface for accessing a datafile is presented in a graphic format having a plurality of objects presented as a universal display screen on a monitor and navigable with an input device. (Borghesi, col. 7, ll. 44-53.) The universal display screen as shown in Figure 6 presents the objects in a graphic format and these objects represent tasks that used in the everyday work environment. (Borghesi, col. 8, ll. 3-8.) The objects are: (a) an in box 88 for receiving assignments,

(b) in process box 90 for holding the datafile being worked on by the user, and (c) out box 88 for transmitting processed assignments. (Borghesi, col. 8, ll. 9-12.) The in box 86 and out box 88 are independent of the computer being utilized, whether the user is using a stand alone computer system (Figure 4), a computer system on a local network (Figure 5), or a computer system on a wide area network. (Borghesi, col. 8, ll. 32-38.) As such, the datafiles are retrieved from the in box 86 and sent from the out box 88. (Borghesi, col. 8, ll. 40-49.) Within the in process box, an individual datafile is opened for being worked on by the user. (Borghesi, col. 8, ll. 65-66.) As such, process of workflow for the user is to retrieve the datafile from the in box 86 and insert the datafile into the in process box 90, work on the datafile while it is within the in process box 90 and pass the augmented datafile to the out box 88. Once the datafile is opened, the user can proceeded in viewing and manipulating the necessary information to process the vehicle claim. (Borghesi, col. 9, l. 8 to col. 10, l. 5.) In addition, while the datafile is in the in process box, if desired, the user can call up the process of calculating a total loss valuation of the vehicle. (Borghesi, col. 13, ll. 14-53.)

3. DeFrancesco teaches a management system where when a function is executed, the system automatically determines the process steps that could be potentially affected by execution of said function and dependent upon the status of those steps determine the process steps

next to be activated. (DeFrancesco, Abstract.) As discussed in DeFrancesco, functions can read or write data elements to a database. (DeFrancesco, col. 5, ll. 46-47.) Such manipulation can affect rule objects and the functions maintain a list of rule objects they manipulate. (DeFrancesco, col. 5, ll. 48-49.) Because a function changes one or more data elements in the database an automatic notification feature is present in order to determine dynamically and efficiently the status of the workflow process steps. (DeFrancesco, col. 6, ll. 53-56.) The automatic notification feature permits the determination of which steps are completed and which steps are to be performed next in response to the functions initiated by the users. (DeFrancesco, col. 5, ll. 58-63.) As such, only process steps that may be affected by a particular function are evaluated and not every process in the workflow every time the function is executed. (DeFrancesco, col. 7, ll. 38-46.) The system maintains a library of all process steps to any workflow and a configuration tool is used to select an existing step or create a new step. (DeFrancesco, col. 8, ll. 38-47.) The process steps are categorized into normal steps, exception steps, and automatic steps. (DeFrancesco, col. 8, ll. 24-25.) Normal steps are actions items that must be completed, exception steps are used when an exception is encountered following the normal steps, and automatic steps are steps that automatically run a function when the step is the next step in the workflow. (DeFrancesco, col. 8, ll. 29-37.) The workflow configuration tool defines the order of the

steps. Some steps can occur in any order, while others must occur before the completion of another step. (DeFrancesco, col. 8, ll. 49-62.)

4. Aquila teaches the utilization of business rules and a web browser to administer insurance claim processing. (Aquila, ¶¶ 0129 and 0091.)

The level of skill in the art

5. Neither the Examiner nor Appellant has addressed the level of ordinary skill in the pertinent art. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error 'where the prior art itself reflects an appropriate level and a need for testimony is not shown'").

Secondary considerations

6. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW RELATED TO OBVIOUSNESS

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

It is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (*see In re Royka*, 490 F.2d 981, 984-85 (CCPA 1974)) and that all words in a claim must be considered in judging the patentability of that claim against the prior art (*In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)).

ANALYSIS RELATING TO REJECTION UNDER 35 U.S.C. § 103(a)

The Appellant argues claims 1, 2, 3, 8, 9, 14, 15, 16, 21, and 22 separately and appropriately identifies them in separate subheadings. Claim 4 depends from claim 3. Claims 5 and 6 depend from claim 1. Claims 10-13 depend from claim 9. Claims 17, 18, and 20 depend from 16. As such, claim 4 stands or falls with claim 3. Claims 5 and 6 stand or fall with 1.

Claims 10-13 stand or fall with claim 9. Claims 17, 18, and 20 would stand or fall with claim 16.[6] 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The obviousness rejection of claim 1

The Examiner found Borghesi's communication server meets the claimed limitation of an insurance claim processing server performing the function of estimating a value of an insurance claim as a function of insurance claim assessment data by (from a remote computer) transmitting a predetermined amount of data relating to a total loss valuation to the server, said amount of data is inputted by the user, and said total loss valuation is sent back to the remote computer. (Answer, 4.) The Examiner stated column 5, line 50 to column 6, line 13, column 7, line 54 to column 8, line 2, column 10, lines 50-56, column 20, lines 33-50, column 29-35, column 23, lines 17-34, and Figures 1 and 7 provide the support. (Answer, 4.) In other words, the passing of data through this server meets the limitation of an insurance claim processing server performing the function of estimating the value of an insurance claim as a function of insurance claim assessment data.

The Appellant contends Borghesi does not disclose an insurance claim processing server performing the function of estimating the value of an insurance claim as a function of insurance claim assessment data. (Supp. Br., 7-8.) The Appellant contends the Examiner has erred in identifying the communication server in Borghesi as an insurance claim processing server

[6] However, because claim 16 is not directed to statutory subject matter, the issue of whether the Appellant has shown the Examiner erred is not reached.

performing the function of estimating the value of an insurance claim as a function of insurance claim assessment data. (Supp. Br. 8.) The Appellant contends the particular server the Examiner has identified as the teaching of the insurance claim processing server is simply a communication server which may or may not be dedicated to insurance claims management. (Supp. Br. 8.)

We find the Appellant's remarks persuasive.

We have reviewed Borghesi. (Finding of Fact 2.) We do not see where Borghesi discloses, teaches, or suggests an insurance claim processing server performing the function of estimating the value of an insurance claim as a function of insurance claim assessment data. Borghesi discloses a communication server connecting the plurality of computers disclosed within. (Finding of Fact 2.) This communication server has a plurality of memory locations for storing datafiles and communications. (Finding of Fact 2.) The computer at the home office contains the mastercopy of the datafile. (Finding of Fact 2.) The datafile is worked-on a one of the remote computers. (Finding of Fact 2.) As such, any calculations are processed at either the home office computer or one of the remote computers and the communication server routes the data to the appropriate computer after any entries or calculations are completed.

The obviousness rejection of claim 9

The Examiner incorporates the analysis presented in claim 1 for the analysis of claim 9 in concluding claim 9 is obvious over the prior art of record. (Answer, 8.)

The Appellant contends again that the communication server of Borghesi passes information among the remote computers and is not an insurance claim processing server performing the function of estimating a value of an insurance claim as a function of insurance claim assessment data. (Supp. Br. 15-16.)

Again, we find the Appellant's remarks persuasive. As such, we incorporate our analysis above for claim 1 herein. In addition, any execution of insurance processing steps occurs either at the home office or one of the remote computers disclosed in Borghesi. (Finding of Fact 2.) Compare this finding of fact to the appropriate claim construction of the claimed method that requires execution of steps to estimate the value to occur within the insurance claim processing server and this step is not met by Borghesi.

Teachings of DeFrancesco and Aquila

We do not see where DeFrancesco corrects the deficiencies found in Borghesi with respect to providing a teaching of an insurance claim processing server performing the function of estimating a value of an insurance claim as a function of claim assessment data. (Finding of Fact 3.) Further, we do not see where the Examiner has identified where Aquila would cure the deficiencies found in Borghesi of the insurance claim

processing server performing the function of estimating a value of an insurance claim as a function of claim assessment data. (Finding of Fact 4.)

CONCLUSIONS OF LAW

We conclude the Appellant has shown that the Examiner erred in rejecting claims 1 and 9 as unpatentable over Borghesi and DeFrancesco.

DECISION

The decision of the Examiner to reject claims 1-11 and 13-15 is reversed.

We do not reach claims 16-18 and 20-22 because these claims are directed to subject matter the court has deemed to be ineligible for patent protection.

We enter a new grounds of rejection of claims 16-18 and 20-22 pursuant to 37 C.F.R. § 41.50(b) under 35 U.S.C. § 101.

NEW GROUND OF REJECTION UNDER 35 U.S.C. § 101

Pursuant to 37 C.F.R § 41.50(b) a new ground of rejection is being included in this opinion.

Claims 16-18 and 20-22 are rejected under 35 U.S.C. § 101 as not being directed to statutory subject matter.

Claim 16 requires a carrier medium upon which information (program instructions) is embedded therein. The Specification describes this carrier medium in one form as a "[s]uitable carrier media" such as "transmission media or signals such as electrical, electromagnetic, or digital signals conveyed via a communication medium such as the network 55 and/or a wireless link" (Specification 9:12-16.) Claims directed to electrical, electromagnetic or digital signals have been held not to be directed to statutory subject matter. *In re Nuijten*, 500 F.3d 1346, 1352 (Fed. Cir. 2007) ("The claims on appeal cover transitory electrical and electromagnetic signals propagating through some medium, such as wires, air, or a vacuum." As such, "[t]hose types of signals are not encompassed by any of the four enumerated statutory categories: 'process, machine, manufacture, or composition of matter.'")

Claims 17, 18, and 20-22 depend from claim 16. The aforementioned claims are directed to either further defining the information embedded on the carrier medium (claims 21 and 22) or further defining the communication protocol (claims 17, 18, and 20) for allowing the information to be exchanged between computers with as little error as possible. As such, these claims add nothing to bring the carrier medium within the fold of statutory subject matter. Therefore, for the same reason *supra* these claims are not directed to statutory subject matter.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960

(August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

hh

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